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10/507,212	09/15/2004	Miki Murakami	257756US6PCT	1787

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EXAMINER	
QAYYUM, ZESHAN	

ART UNIT	PAPER NUMBER
3685	

NOTIFICATION DATE	DELIVERY MODE
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No.	Applicant(s)	
	10/507,212	MURAKAMI ET AL.	
	Examiner	Art Unit	
	ZESHAN QAYYUM	3685	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *24 April 2009*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,3-8 and 14-19* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1, 3-8, 14-19* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Status of Claims

1. Claims 1, 3-8, 14-19 have been examined.

Response to Arguments

2. Applicant's arguments filed 04/24/2009 have been fully considered but they are not persuasive.
3. The Applicant is of the opinion that prior art fails to teach "means for receiving a request from the client, which has already acquired the contents and the license for content, for authorization to transfer the content to a move destination client" and "contents copy certificate supply means for generating, in response to the request received from the client, a contents copy certificate that identifies the move destination client ..." The Examiner respectfully disagrees.
4. Abburi discloses: "means for receiving a request from the client, which has already acquired the contents and the license for content (See column 13, 1-20), for authorization to transfer the content to a move destination client" and "contents copy certificate supply means for generating, in response to the request received from the client, a contents copy certificate (i.e. license) that identifies the move destination client (i.e. name and machine ID) ..." (See Fig 25, column 60, lines 1-41, column 30, lines 40-42)
5. Regarding claim 3 and 4 argument, The Examiner respectfully disagrees. Claims 3 and 4 recited functional language/intended use of content distribution system. Claims just describing details about client and move destination client.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claims 1, 3-8, 15, and 18-19 are rejected under 35 U.S.C. §101 because the claimed invention is directed to non-statutory subject matter.

7. Claims 1 directed to a content distribution system. Specifically, Claim 1 recites registration mean, content supply mean, license mean, content copy supply mean etc. However, this is merely software, and it has been held that software without a required computer-readable medium-storing software that, when executed, causes the computer to perform a particular process or method (MPEP 2106.01) is merely nonfunctional descriptive material and non-statutory under 35 U.S.C. 101.

8. Claims 3-8 are also rejected as each depends from claim 1.

9. With respect to claim 15, Based on Supreme Court precedent (See also *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876)) and recent Federal Circuit decisions, a §101 process must (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. In addition, the tie to a particular

apparatus, for example, cannot be mere extra-solution activity. See *In re Bilski*, 88 USPQ2d 1385 (Fed. Cir. 2008).

An example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps.

To meet prong (1), the method step should positively recite the other statutory class (the thing or product) to which it is tied. This may be accomplished by having the claim positively recite the machine that accomplishes the method steps. Alternatively or to meet prong (2), the method step should positively recite identifying the material that is being changed to a different state or positively recite the subject matter that is being transformed.

10. Claims 18-19 are also rejected as each depends from claim 15.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

11. Claims 1, 3-8, 14-19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

12. Claims 1, 14, 15 recite "a client", "a request" in line 7, it is unclear to one of the ordinary skill in the art is this client and request is the same as recites in line 6 or different one? (In re Zletz, 13 USPQ2d 1320 (Fed. Cir. 1989)).

13. Claim 15 rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. The omitted steps are: requesting for the contents.

14. Claim 3 recites "...client and move destination client are registered with different license supply means...."It is unclear to one of the ordinary skill in the art because the system only has one "license supply means" and the license supply means (claim 1) only communicates with a request from a client, as opposed to the move destination client and claim 3 requires at least two. (In re Zletz, 13 USPQ2d 1320 (Fed. Cir. 1989)). Claims 16 and 18 are also unclear and rejected as each have the same limitations as claim 3.

15. Claim 15 recites "supplying the contents copy certificate to the client" It is unclear to one of the ordinary skill is this client is the destination client or just to client? (In re Zletz, 13 USPQ2d 1320 (Fed. Cir. 1989)).

16. Claims 3-8, 16-17 and 18-19 are also rejected as each depends from claim 1, 14 and 15 respectively.

17. Claim 18 recites "registering the client...supply servers, which each supply its own public key" It is unclear to one of the ordinary skill that are the server who provide public key or client and move destination client or every one for example servers, client and move destination client? (In re Zletz, 13 USPQ2d 1320 (Fed. Cir. 1989)).

18. Claim 19 recites "supplying the contents copy certificate" It is unclear to one of the ordinary skill to whom this content copy certificate supply for example which client? (In re Zletz, 13 USPQ2d 1320 (Fed. Cir. 1989)).

19. Claim 19 recites "verifying that the client is legal" It is unclear to one of the ordinary skill how is this verification implemented? (In re Zletz, 13 USPQ2d 1320 (Fed. Cir. 1989)).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

20. Claims 1, 14, and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by Abburi (US 7203966).

21. With respect to claim 1, 14 and 15, Abburi discloses: registering each client of the user and acquiring customer-related information (See column 57, lines 65-67 and column 58, lines 1-6, 55-67) managing customer-related information (See column 58, lines 55-67 and column 59, lines 1-10) supplying contents to a client in compliance with a request from the client (See column 2, lines 51-67, column 3, lines 1-4) supplying, in compliance with a request from a client, a license for said contents to the client who has acquired the contents (See column 2, lines

63-67 and column 3, lines 1-15) receiving a request from the client, which has already acquired the contents and the license for said contents, for authorization to transfer the content to a move destination client, generating, in response to the request received from the client, a contents copy certificate (i.e. license) that identifies the move destination client (i.e. name and Machine ID) , contains a license for the move destination client and indicates that a transfer of the content from the client to the move destination client is legal (See Fig 25, column 60, lines 1-41, column 30, lines 40-42) supplying the content copy certificate (i.e. license) to the client (See column 60, lines 19-26)

In addition "... identifies the ..., indicates..." are non functional descriptive material. Therefore, it has been held the nonfunctional descriptive material will not distinguish the invention from prior art in term of patentability. (In re Gulack, 217 USPQ 401 (Fed. Cir. 1983), In re Ngai, 70 USPQ2d (Fed. Cir. 2004), In re Lowry, 32 USPQ2d 1031 (Fed. Cir. 1994); MPEP 2106.01 II).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

22. Claims 3-8, 16-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Abburi (US 7203966).

23. With respect to claims 3, 16 and 18, Abburi discloses all the limitations as described above. Abburi further discloses: registering the client and the move destination client with license supply server, which each supply its own public key (See column 28, lines 22-24, column 58, lines 55-67) electronically signing the contents copy certificate with a secret key of a license supply server with which the move destination client is registered (See column 28, lines 22-32) Abburi discloses clients are registered with the content provider/license server (for example Microsoft) (See column 4, lines 51-67, column 13, lines 21-32 and column 58, lines 55-67) Abburi does not explicitly disclose clients are registered with different license servers. However, the predictable result would be to register the clients to different content provider/license server available at the time of invention for example to IBM, Apple, etc. to get the license for other product or content. (*KSR International Co. v. Teleflex Inc., 82 USPQ2d 1385 (U.S. 2007).* ***In addition*** claims 3 and 16 state "wherein the contents move source client and the contents move destination client are registered with different license supply means so that each license supply means supplies its own public key to the registered client, and wherein said contents copy certificate supply means electronically signs the contents copy certificate with a secret key of a license supply means with which the contents move destination client is registered". This is functional language/intended use of content distribution system. However, it has been held while features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior

art in terms of structure rather than function alone. (MPEP 2114; In re Swineheart, 169 USPQ 226; In re Schreiber, 44 USPQ2d 1429 (Fed. Cir. 1997)).

24. With respect to claims 4, 17 and 19, Abburi discloses all the limitations as described above. Abburi further acquiring a license ID concerning the contents to be transferred (See column 58, lines 12-22 and Fig 25) and a client ID of the move destination client from said client (See column 58, lines 29-67); verifying that the client is legal, and that the client has already acquired a license for the contents to be transferred, and further verifying that the user owning the client actually owns the move destination client (i.e. register devices); and supplying the contents copy certificate (See column 58, lines 1-67, column 59, lines 1-67 and Fig 25)

In addition claims 4 and 17 state "wherein said contents copy certificate supply means acquires a license ID concerning the contents to be moved and the client ID of a move destination client from said contents move source client, sends an inquiry to said customer-related information management means to verify that the move source client is legal, and that the move source client has already acquired a license for the contents to be moved, and further that the user owning the move source client actually owns the move destination client, and then supplies a contents copy certificate". This is functional language/intended use of contents copy certificate supply mean. However, it has been held while features of an apparatus may be recited either structurally or functionally, claims directed to an

apparatus must be distinguished from the prior art in terms of structure rather than function alone. (MPEP 2114; In re Swineheart, 169 USPQ 226; In re Schreiber, 44 USPQ2d 1429 (Fed. Cir. 1997)).

25. With respect to claim 5, Abburi discloses all the limitations as described above. Abburi further discloses: wherein said customer-relate information management means manages a table (See column 58, lines 55-67 and Fig 25) With respect to "defining the association between leaf IDs and client IDs, a table defining the association between client IDs and client public key certificates, a table defining the association between client IDs and user IDs, a table defining the association between contents IDs and license IDs, a table defining the association between user IDs and contents IDs of downloaded contents, a table defining the association between user IDs and license IDs of downloaded licenses, and a history of contents copy certificate issues" these are nonfunctional descriptive material. It is describing the data stored in the table. Therefore it has been held stored data will not distinguish the invention from the prior art in term of patentability. (In re Gulack, 217 USPQ 401 (Fed. Cir. 1983), In re Ngai, 70 USPQ2d (Fed. Cir. 2004), In re Lowry, 32 USPQ2d 1031 (Fed. Cir. 1994); MPEP 2106.01 II).

26. With respect to claim 6, Abburi discloses all the limitations as described above. Abburi further discloses: wherein said customer-related information management

means updates the customer-related information each time said contents supply means supplies contents to a client and/or each time said license supply means supplies a license to a client. (See column 61, lines 7- 24, 30-42 and column 62, lines 43-65).

27. With respect to claim 7, Abburi discloses all the limitations as described above. Abburi further discloses: further comprising billing process means for performing a billing process on a client in accordance with a license supply and/or a contents copy certificate supply to the client. (See column 21, lines 35-46 and column 22, lines 43-52).

28. With respect to claim 8, Abburi discloses all the limitations as described above. Abburi further discloses: the amount billed (i.e. fee) by said billing process means for a license supply ((See column 21, lines 35-46 and column 22, lines 43-52). Hurst discloses: the amount billed for a contents copy certificate (i.e. rights) supply (See column 5, lines 5-11 and 21-22). Further it would be a predictable result of a provider charging a user for license supply and content copy certificate supply to charge any amount for the content that the provider desired. (KSR International Co. v. Teleflex Inc., 82 USPQ2d 1385 (U.S. 2007)).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ZESHAN QAYYUM whose telephone number is (571)270-3323. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Calvin L. Hewitt can be reached on (571)272-6709. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Z. Q./
Examiner, Art Unit 3685

/Calvin L Hewitt II/
Supervisory Patent Examiner, Art Unit 3685